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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,995	05/31/2005	David Rees Mugeli	6002-1083	9943
466	7590	06/25/2007		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER TALBOT, MICHAEL	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 06/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/536,995

Applicant(s)

MUGELI, DAVID REES

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/31/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because of reference to purported merits or speculative applications. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

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2. The disclosure is objected to because of the following informalities:

Refer to the Abstract, line 1, an "s" should be added to the word "include" within the phrase "The drill (20) include a shear off safety feature." so as to read --The drill (20) includes a shear off safety feature--.

Refer to page 1, line 3, the capitalization of the entire word "THIS" should be changed so as to capitalize only the first letter "T" so as to read --This--.

Refer to "Amendment to the Specification", last line stating "Please cancel the paragraph beginning on page 3, line 6.". Applicant is required to submit a subsequent "Amendment to the Specification" showing the entire paragraph in question using strikeout to signify the cancellation of the desired paragraph. This will clarify the specific paragraph in question as Examiner believes upon review of the amended text that Applicant intentions was to delete the paragraph beginning on page 3, line 3, not page 3, line 6 as requested.

Refer to page 4, line 12, the use of two periods ".." should be changed so as to use only a single period ".".

Refer to page 7, line 6, the phrase "due to greater control of the drill is less awkward situations.." should be changed by changing "is" to --in-- and using only a single period "." at the end so as to read --due to greater control of the drill in less awkward situations.--

Appropriate correction is required.

### ***Double Patenting***

3. Applicant is advised that should claim 16 be found allowable, claim 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Objections***

4. Claims 2-4 and 14-33 are objected to because of the following informalities:

The claims are replete with the spelling error regarding the units of measure of foot-pounds. The correct spelling and/or nomenclature should be "ft-lbs".

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by DD 203260. DD 203260 shows in the Figure a rotary bit with a shank (1,2,4,5) adapted to locate in a chuck comprising an insert end (4,5) and an end section (1,2) extending from the insert end having at least one elongate flat (at 1) which locates inside the chuck when the shank is operatively engaged in the chuck, and a wasted safety section (3) spaced from the insert end sufficiently so that when the shank is operatively engaged in the chuck, the wasted safety section is outside the chuck and the wasted safety section having a predetermined shear torque rating so that the shank shears at the wasted safety section if the predetermined shear torque is exceeded (Abstract). DD 203260 shows the shank including a further flat outboard (at 4) of the wasted safety section so that after the wasted safety section has been sheared, if necessary, a user may still use the bit on a temporary basis to complete a drilling task (Abstract).

7. Claims 1 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 29700943. DE 29700943 shows in Figs 1-3 a rotary bit (5) with a shank (7) adapted to locate in a chuck comprising an insert end (10) and an end section (13) extending from the insert end

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having at least one elongate flat (8) which locates inside the chuck when the shank is operatively engaged in the chuck, and a wasted safety section (15) spaced from the insert end sufficiently so that when the shank is operatively engaged in the chuck, the wasted safety section is outside the chuck and the wasted safety section having a predetermined shear torque rating so that the shank shears at the wasted safety section if the predetermined shear torque is exceeded (Abstract). DE 29700943 shows the shank including a further flat outboard (12) of the wasted safety section so that after the wasted safety section has been sheared, if necessary, a user may still use the bit on a temporary basis to complete a drilling task (Abstract).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-4, 14-16, 19-21, 24-26, 29-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over DD 203260. DD 203260 does not disclose expressly the shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs. Instead, DD 203260 is silent to the specific values of the shear torque rating. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select "a shear torque rating of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, or 5-40 ft-lbs" because Applicant has not disclosed that the "shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs" provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the rotary tool of DD 203260, and Applicant's rotary tool to perform equally well with either the "undisclosed shear torque rating" as taught by DD 203260 or the claimed "shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs,

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25-30 ft-lbs, and 5-40 ft-lbs" because both levels of shear torque ratings would generate the desired result of localized fracture to the rotary tool shaft, thus preserving the rotary tool for further use, if needed.

Furthermore, Applicant does not provide any criticality or unexpected results for the "shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs" as recited in claims 2-4,14-16,19-21,24-26 and 30-33.

10. Claims 12,13,17,18,22,23,27,28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over DD 203260 in view of Wanner '057. DD 203260 lacks the rotary bit having a code thereon to provide information to the user about the rotary bit (i.e. type, size, material composition, or mechanical properties). Wanner '057 shows a rotary bit (48,58) having a code (50,60) thereon to provide information to the user about the rotary bit (col. 4, line 66 through col. 5, line 31). In view of this teaching of Wanner '057, it would have been obvious to one of ordinary skill in the art to modify the rotary bit of DD 203260 to include coded information on the tool shaft as taught Wanner '057 to provide the user with important safety information as to the tool operational capabilities through the use of indicia.

11. Claims 2-4,14-16,19-21,24-26,29-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 29700943. DE 29700943 does not disclose expressly the shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs. Instead, DE 29700943 is silent to the specific values of the shear torque rating. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select "a shear torque rating of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, or 5-40 ft-lbs" because Applicant has not disclosed that the "shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs" provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the rotary tool of DE

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29700943, and Applicant's rotary tool to perform equally well with either the "undisclosed shear torque rating" as taught by DE 29700943 or the claimed "shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs" because both levels of shear torque ratings would generate the desired result of localized fracture to the rotary tool shaft, thus preserving the rotary tool for further use, if needed.

Furthermore, Applicant does not provide any criticality or unexpected results for the "shear torque ratings of 15-30 ft-lbs, 15-20 ft-lbs, 25-30 ft-lbs, and 5-40 ft-lbs" as recited in claims 2-4, 14-16, 19-21, 24-26 and 30-33.

12. Claims 12, 13, 17, 18, 22, 23, 27, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 29700943 in view of Wanner '057. DE 29700943 lacks the rotary bit having a code thereon to provide information to the user about the rotary bit (i.e. type, size, material composition, or mechanical properties). Wanner '057 shows a rotary bit (48, 58) having a code (50, 60) thereon to provide information to the user about the rotary bit (col. 4, line 66 through col. 5, line 31). In view of this teaching of Wanner '057, it would have been obvious to one of ordinary skill in the art to modify the rotary bit of DE 29700943 to include coded information on the tool shaft as taught Wanner '057 to provide the user with important safety information as to the tool operational capabilities through the use of indicia.

### ***Conclusion***

13. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300.



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This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT  
Examiner  
13 June 2007



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SUPERVISORY PATENT EXAMINER